UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/453,936	05/17/2000	Tetsuro Motoyama	5244-0125-2	7315

			EXAMINER
22850	7590	02/05/2004	EDELMAN, BRADLEY E

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ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No. 09/453,936	Applicant(s) MOTOYAMA ET AL.	
	Examiner Bradley Edelman	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _03 December 2003_.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-22_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-22_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _17 May 2000_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
    since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
    37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
    reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for

reconsideration filed on December 3, 2003. Claims 1-22 are presented for examination.

Claims 19-22 are new claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claims 1-11 and 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated

by Merritt et al. (U.S. Patent No. 6,421,429, hereinafter "Merritt").

In considering claim 1, Merritt discloses a computer program product for

controlling a combination of protocol ("protocol") and format ("format") used to

communicate event data between a remote receiver ("receiving station") and a device

("sender station") comprising:

First computer code means for selecting a protocol to transfer event data

between the remote receiver and the device (col. 3, lines 8-11, wherein the calling party

selects a protocol and format for sending a file);

Second computer code means for selecting a first format to transfer event data between the remote receiver and the device (col. 3, lines 12-15, wherein the terminating party stores a preferred protocol and format for reception in a database); and

Third computer code means for determining, subsequent to the selection of the protocol and the format, if the selected protocol is compatible with the first selected format (col. 3, lines 11-18, "the originating party's sending file format and protocol is compared to the preferred profile for the terminating party... If the originating and terminating image file formats match, then a direct communications channel... is established"). See also, col. 11, lines 17-36, describing a handshake procedure for selecting a compatible format and protocol for the communication between the two devices.

In considering claim 2, Merritt further discloses a fourth code means for selecting a second format for transferring event data if the first format is not compatible with the selected protocol, and for ensuring that the second format is compatible with the protocol (col. 4, lines 33-46, wherein the system performs a look-up routine that traverses the subscriber profile database to find a compatible format and protocol for sending the information).

In considering claim 3, Merritt further discloses a fourth code means for selecting a second format for transferring event data after selecting the first format, and for transmitting the data to the device using the second format (col. 4, lines 33-46, wherein

the system performs a look-up routine that traverses the subscriber profile database to find a compatible format and protocol for sending the information). In addition, Merritt further discloses only using the second format if the protocol supports only one format at a time (i.e. a FAX transmission protocol can support only one fax message in one fax format at a time, and thus messages sent as faxes will use only the second, fax, format; Merritt, col. 5, lines 58-60).

In considering claims 4 and 5, Merritt further discloses a fourth computer code means for selecting a second format to transfer event data between the remote receiver and the device, and a fifth computer code means to transmit the data to the remote receiver from the device using the first and second formats if the protocol supports plural formats at a time (col. 10, lines 13-43; col. 8, lines 50-67). In addition, Merritt further discloses that the different formats are sent either sequentially or in parallel, as required by claims 4 and 5 respectively (wherein given the types of information being sent – i.e. fax, graphics, images, video, teleconferencing – the system necessarily requires that certain formats are sent in parallel, such as audio and video for teleconferencing, and that other formats are sent sequentially, such as video and images that must be viewed separately.

In considering claim 6, Merritt further discloses storing a first indicator, corresponding to a protocol selected, in a map entry, and storing a second indicator,

corresponding to the first format, in a the map entry (col. 5, lines 1-12, wherein the profile database and look-up tables store each of the protocols and compatible formats).

In considering claim 7, the system taught by Merritt inherently compares the first and second indicators against values in a data structure corresponding to at least one compatible format for a specified protocol (i.e. in order to determine the compatible format and protocol from the look-up table and the selected formats and protocols, it must perform the comparison).

In considering claim 8, the system taught by Merritt inherently compares the first and second indicators against values in a data structure corresponding to at least one compatible protocol for a specified format (i.e. in order to determine the compatible format and protocol from the look-up table and the selected formats and protocols, it must perform the comparison).

In considering claim 9, the system taught by Merritt inherently discloses iterating over values in a data structure corresponding to at least one compatible protocol for a specified format (i.e. in order to determine the compatible format and protocol from the look-up table and the selected formats and protocols, it must perform such iteration).

In considering claim 10, the system taught by Merritt inherently discloses iterating over values in a data structure corresponding to at least one compatible format for a

specified protocol (i.e. in order to determine the compatible format and protocol from the look-up table and the selected formats and protocols, it must perform such iteration).

In considering claim 11, Merritt further discloses that the first through third computer code means comprise a library of code shared between first and second applications (col. 5, lines 29-32, "library of image processing software to be maintained and shared economically by many users").

In considering claim 13, claim 13 is a parallel method claim to claim 1, and is thus rejected for the same reasons.

In considering claim 14, claim 14 is a parallel method claim to claim 2, and is thus rejected for the same reasons.

In considering claim 15, claim 15 is a parallel method claim to claim 3, and is thus rejected for the same reasons.

In considering claim 16, claim 16 is a parallel method claim to claim 4, and is thus rejected for the same reasons.

In considering claim 17, claim 17 is a parallel method claim to claim 5, and is thus rejected for the same reasons.

In considering claim 18, claim 18 is a parallel method claim to claim 6, and is thus rejected for the same reasons.

In considering claims 19 and 21, Merritt further discloses that the event data is generated by an internal operation of the device (col. 3, lines 7-11, "calling party 18 initiates an image communication").

In considering claims 20 and 22, Merritt further discloses transferring the event date between the remote receiver and the device (col. 3, lines 14-17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt.

In considering claim 12, although Merritt discloses the use of that the first through third computer code means comprise a library of code shared between first and second applications (col. 5, lines 29-32, "library of image processing software to be maintained and shared economically by many users"), Merritt does not explicitly disclose that the library is a dynamic link library. Nonetheless, Examiner takes Official notice that the use

of dynamic link libraries in conjunction with network applications is well known in the art.

Thus, given this knowledge, a person having ordinary skill in the art would have readily

recognized the desirability and advantages of using dynamic link libraries in conjunction

with the libraries of software taught by Merritt, because such libraries avoid the need to

rewrite code for every new program or application. Therefore, it would have been

obvious to use dynamic link libraries for the applications in the system taught by Merritt.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
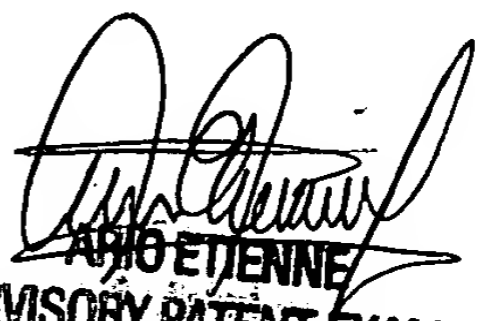
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BE
January 28, 2004

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100